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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,794	07/25/2001	Roland Noll	5596	4892

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,794	NOLL ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *27-30 and 34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26,31-33 and 35-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of invention B, claims 1-26, 31-33 and 35-40, in the reply filed on 6 September 2006 is acknowledged. Applicant's withdrawal of the non-elected claims 27-30 and 34 is also acknowledged.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 4, 6, 7, 11, 15, 17, 18 ,20, 21, 23, 24, 31-33 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by James (*Medical Marketing and Media*, January 1994).

5. James teaches (independent claims 1, 31 and 35) a method of providing a branded channel, wherein the branded channel is associated with a brand and the branded channel includes branded channel content that is relevant or related to the brand, the method comprising the steps of:

delivering the branded channel (*Healthtouch* from Medical Strategies, Inc., item marked "B" on p. 43) via a communication medium (an interactive machine in a pharmacy, item marked "A" on p. 43);

displaying the branded channel content, whereby the displaying step displays branded channel content that is associated with other content (*An ad for a related product*, item

marked "C" on p. 43, or the products of Glaxo and Fisons, item marked "D" on p. 44), the other content including a first progressive marketing opportunity (*An ad for a related product*, item marked "C" on p. 43, or the coupons, item marked "E" on p. 44; and

displaying the first progressive marketing opportunity (*An ad for a related product*, item marked "C" on p. 43), wherein the first progressive marketing opportunity is a marketing opportunity that is related to the displayed branded channel content.

6. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

7. The instant application contains numerous special terms with no such "clear definition". Chief among them is "branded channel". The phrase is supported by non-elected claims 27-30, but these claims only define a "branded channel" as a communications channel that comprises "branded content". The term is also supported by para. [0006] to [0008] of the published application (US 20020022970A1). Therein the spec. suggests that a branded channel is "a consumer-oriented channel that is devoted to a single brand". This is not helpful because it begs the question "what is a brand?" Is "Proctor and Gamble" a brand, or is its trademark, Ivory®, a "brand"? For that matter, are the Proctor and Gamble products "Ivory® soap" and "Ivory® dishwashing liquid"? the same brand or different brands?

8. Applicant also notes (para. [0007] of the published application), "There does not exist a consumer-oriented channel that is devoted to a single brand." This again depends on what applicant means by "brand".

9. In the instant case, the examiner is required to give the term "brand" its broadest reasonable interpretation, which the examiner judges to be "a class of goods identified by a name as the

product of a single firm or manufacturer: make". This is definition 4a of "brand" in Merriam-Webster's Collegiate Dictionary (10th ed.). Hence, in the example given in para. 7 above, the brand is "Proctor and Gamble".

10. By this logic, the examiner does not agree with applicant's premise that "There does not exist a consumer-oriented channel that is devoted to a single brand." Every common commercial channel is devoted to a single brand, which is to say its own brand: ABC, CNN, QVC, etc. That is acknowledged in the discussion of cable company brand extension and identification in Paikert (as marked in two places of the record copy p. 2/5). In James, the brand is "Medical Strategies, Inc." and their product is the programming. Said programming product of Medical Strategies also reads on "branded channel content".

11. The examiner senses that by "branded channel" applicant meant a channel characterized by a brand other than that of the channel provider, e.g., a "Proctor and Gamble" channel. Under the law, in order to be entitled to this interpretation, applicant would at very least have had to disclose this limitation in the application as originally filed.

12. Yet even then, it is not clear to the examiner that such a branded channel would be functionally distinct from the prior art made of record. Applicant suggests (para. [0006] of the published application) that there is special utility in having, for example, a "Proctor and Gamble" branded channel, but that is not clear from the examiner's experience. Both radio and television have had entire programs sponsored by a single brand, but that single-sponsor practice has largely disappeared. If there is no showing of special utility, the distinction between a channel branded "CNN" versus one branded "Proctor and Gamble" would be non-functional, and the examiner could not give patentable weight to such a limitation (MPEP § 2106.01 and 2112.01).

13. Because of the lack of clear definition in the spec., no patentable weight was given to "progressive" or "moment in time" marketing opportunity.

14. James also teaches at the citations given above claims 3 (the choice to use the interactive machine reads on user selection), 4, 15, 17 (the *interactive machine* reads on an interactive kiosk), 18, 20, 23, 24, 32, 33 (no patentable weight was given to the nonfunctional limitation "whose products are contained in the aisles"), 37, 38 and 39 (inherently).

15. James also teaches claims 6, 7, 11, 21, 36 and 40 (item marked "F" on p. 44). For claim 40, *related products* reads on "links to other content".

16. Claims 1, 3, 9, 10, 12, 15-19, 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Erlick ("QVC on demand", *HFN*, 6 March 1995).

17. In addition to the claims discussed above, Erlick teaches claims 9 and 10 (the Sony program reads on bundled branded channels and content), 12, 16, 19 and 25 (inherent for ordering over a PC).

18. Claims 2, 5, 8, 13, 14, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over QVC.

19. Erlick does not teach (claims 2 and 8) high bandwidth content and a broadband medium. Official notice is taken (MPEP § 2144.03) that both were common in television and Internet service at the time of the invention. Because it would enhance customer enjoyment and product sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a broadband medium and high bandwidth content to the teachings of Erlick.

20. Erlick does not teach (claim 5) filtering content. It was common for adult TV users to control or restrict content, which reads in filtering. Erlick does not teach (claims 13 and 14) ordering installation or parts for delivery. Both would be obvious additions to the teachings of Erlick because Erlick teaches that QVC is the world's largest electronics retailer.

21. Erlick does not teach (claims 22 and 26) providing and exchanging credits. This is common with rewards credit cards, and an obvious addition to the teachings of Erlick.

Conclusion

22. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Paikert (*Multichannel News*, December 1996) teaches that cable channel executives are concerned with their brand identification and extension. Brumback (*Supermarket News,* Feb. 1994) and Goetzl (*Advertising Age*, November 1999) both teach in-store channels.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

24. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

26 November 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER